

Applicants : Steven D. Schwartz et al.
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Filed : January 6, 2004
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REMARKS

Claims 19-34 are pending and under examination in the subject application.

Information Disclosure Statement

An Information Disclosure Statement was filed with the subject application on January 6, 2004. The Examiner requested that applicants submit copies of previously submitted non-patent references since the Examiner does not have access to these documents. As a courtesy to the Examiner, and to expedite prosecution of the subject application, applicants attach hereto copies of the twelve non-patent references that are listed on the forms PTO/SB/08A-B (3 pages) filed with the Information Disclosure Statement on January 6, 2004. Applicants believe that no fee is due in connection with this submission since the IDS was previously filed and since these non-patent references were previously submitted to or cited by the Patent Office during the prosecution of U.S. Patent Application Nos. 09/711,625 and/or 09/100,741, from which the subject application claims the benefit of its filing date under 35 U.S.C. §120. Pursuant to 37 C.F.R. §1.98(d), copies of such previously cited or submitted references are not required to be included with an Information Disclosure Statement.

Double Patenting Rejections

1) Claims 20, 26, 27, 28, and 21, 29, 30, 31, and 22, 32, 33, 34 are rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,678,618.

Applicants respectfully traverse this rejection.

Applicants note that "same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

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1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). MPEP §804 (II)(A). Statutory double patenting does not exist when the scope of one claim is different than the scope of another claim. MPEP §804 (II)(A).

Applicants note that the claims in U.S. Patent No. 6,678,618 are drawn to a method and a computer readable medium for determining a free energy of binding of a potential transition-state inhibitor to an enzyme. In contrast, the claims in the subject application are drawn to methods and computer readable media for determining a free energy of binding of either a potential inhibitor to an enzyme or a potential substrate to an enzyme. Accordingly, the pending claims in the subject application are broader than those in U.S. Patent No. 6,678,618.

Applicants attach hereto a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) to obviate a future potential obviousness-type double patenting rejection over U.S. Patent No. 6,678,618.

In view of the remarks made hereinabove and the Terminal Disclaimer attached hereto, applicants respectfully request reconsideration and withdrawal of double patenting rejection over U.S. Patent No. 6,678,618.

2) Claims 18-34 are rejected under judicially created obviousness type double patenting over claims 1-6 of prior U.S. Patent No. 6,185,548.

Applicants respectfully traverse this rejection.

Applicants note that the claims in U.S. Patent No. 6,185,548 are drawn to a method and a computer readable medium for determining a free energy of binding of a potential ligand to a receptor. In contrast, the claims in the subject application are drawn to methods and a computer readable media for determining a free energy of binding of either a potential inhibitor to an enzyme or a potential substrate to an

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enzyme. Applicants further note that the claims of Application No. 09/100,741, now U.S. Patent No. 6,158,548, were subjected to a requirement in an Office Action issued by the Patent Office on March 21, 2000, that prosecution be restricted to one of the following two groups of inventions: Group I - claims drawn to a method of predicting ligand receptor binding affinity and a computer readable medium comprising the instructions, and Group II - claims drawn to a method of predicting transition state inhibition-enzyme inhibition and a computer readable medium comprising the instructions.

Nevertheless, in order to expedite prosecution of the subject application, applicants attach hereto a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) to overcome the obviousness-type double patenting rejection over U.S. Patent No. 6,185,548.

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CONCLUSIONS

In view of the remarks made hereinabove and of the attached Terminal Disclaimers, applicants respectfully request reconsideration and withdrawal of the rejections set forth in the August 17, 2004 Office Action and passage of pending claims 19-34 to allowance.

If there are any minor matters that prevent allowance of the subject application, applicants request that the Examiner telephone the attorneys listed below.

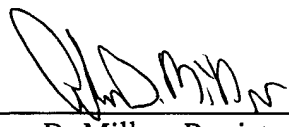
A check for \$110.00 is enclosed to cover the fee for a small entity for filing two Terminal Disclaimers (\$55.00 per disclaimer). No other fee is deemed necessary in connection with the filing of this Communication. However, if any other fee is required to maintain the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785. Overcharges may also be credited to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Applicants
90 Park Avenue
New York, New York 10016
(212) 336-8000

Dated: October 26, 2004
New York, New York

By


Alan D. Miller, Registration No. 42,889
Craig J. Arnold, Registration No. 34,287